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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/556,964

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Gene Huh

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HARNESS, DICKEY & PIERCE, P.L.C.
P.O. BOX 828
BLOOMFIELD HILLS, MI 48303

EXAMINER

RUNNING, RACHEL A

ART UNIT

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3732

MAIL DATE

DELIVERY MODE

12/17/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/556,964	Applicant(s) HUH, GENE	
	Examiner RACHEL A. RUNNING	Art Unit 3732	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 October 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) 9 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-8 and 10-19 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 16 November 2005 is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☒ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>5/21/2008; 11/16/2005</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

1. Applicant's election without traverse of Group I in the reply filed on October 22, 2008 is acknowledged.
2. Claim 9 is withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected Group, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on October 22, 2008.
3. The election/restriction is therefore made FINAL.

Priority

4. Acknowledgment is made of applicant's claim for foreign priority based on applications filed in Japan on 5/19/2003 and 4/19/2004. It is noted, however, that applicant has not filed a certified copy of the Japanese applications as required by 35 U.S.C. 119(b).

Specification

5. The abstract of the disclosure is objected to because the abstract contains more than 150 words. Correction is required. See MPEP § 608.01(b).
6. Applicant is reminded of the proper language and format for an abstract of the disclosure.

The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 150 words. It is important that the abstract not exceed 150 words in length since the space provided for the abstract on the computer tape used by the printer is limited. The form and legal phraseology often used in patent claims, such as "means" and "said," should be avoided. The

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abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details.

The language should be clear and concise and should not repeat information given in the title. It should avoid using phrases which can be implied, such as, "The disclosure concerns," "The disclosure defined by this invention," "The disclosure describes," etc.

Drawings

7. The drawings are objected to because Figures 3 (a, b, and c) should be separately labeled Figure 3a, Figure 3b, and Figure 3c. Figures 4 (a, b, and c), Figure 5 (a, b, c, and d), and Figure 6 (a, b, and c) should also be separately labeled. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Objections

8. Claims 1, 2, 6, and 8 are objected to because of the following informalities:
9. Claims 1, 2, and 8, line 1, states "a rod part having one end and the other end", examiner suggests changing the statement to "a rod part having one end and another end" to avoid any lack of antecedent basis for "the other end".
10. Claim 6, is dependant from claim 1, claim 1 already claims "a rod-shaped member...an erecting action surface...and a first magnet", therefore, claims 6 does not need to claim "a first rod-shaped member...a first erecting action surface...a first magnet" examiner suggests changing claim 6 to state, "wherein said mount surface can accommodate a second rod-shaped member side-by-side with said rod-shaped member and is formed with a second a second erecting action surface...".

Appropriate correction is required.

Claim Rejections - 35 USC § 102

11. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

12. Claims 1, 2, 4, 10, 13-15, and 17 are rejected under 35 U.S.C. 102(b) as being anticipated by Japanese reference 2-249504 herein referred to as Reference '504.

Regarding claim 1, Reference '504 discloses, a self-erecting structure for a rod-shaped member comprising a rod-shaped member (5) including a rod part having one end and another end and an erecting operation part (4) provided at the one end of the

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rod part (see Figure 1; abstract). A container (1) includes a mount surface (6) capable of accommodating the rod member in a lying position; the mount surface has an erecting action surface (3) for the erecting operation part of the rod member to perform an erecting action thereon (see Figures 1 and 2). The container further includes a lid (2) capable of opening and closing an open part of the mount surface (see Figures 1 and 2). The erecting operation part of the rod member has a rolling surface (i.e. bottom part of 4) that is rollable on the erecting action surface in an erecting direction of the rod member (see Figures 5 and 6). An erecting support surface (i.e. end of 5) is formed adjacent to and forward of the rolling surface at one end of the rod member and a first magnet (4) is provided in a vicinity of the erection support surface the first magnet has a first magnetic pole facing toward the one end of the rod member so that the magnetic force from the first magnetic pole acts on the erection support surface (see Figures 1-3, abstract). The container (1) has a second magnet (3) provided in a vicinity of the erecting action surface the second magnet has a second magnetic pole opposite in polarity to the first magnetic pole and the second magnetic pole faces upward so that magnetic force from the second magnetic pole acts on the erecting action surface wherein the rod member is constantly urged to pivot in the erection direction by magnetic attraction force between the first magnetic pole and the second magnetic pole (see Figures 1 and 5; abstract). The lid (2) of the container (1) has an erection restraining part (i.e. the position located next to mirror 7) capable of holding the rod member in the lying position on the mount surface against urging form acting on the rod member in the erecting direction when the lid is closed (see Figure 2).

Regarding claim 2, Reference '504 discloses, a self-erecting structure for a rod-shaped member comprising a rod-shaped member (5) including a rod part having one end and another end and an erecting operation part (4) provided at the one end of the rod part (see Figure 1; abstract). A container (1) includes a mount surface (6) capable of accommodating the rod member in a lying position; the mount surface has an erecting action surface (3) for the erecting operation part of the rod member to perform an erecting action thereon (see Figures 1 and 2). The container further includes a lid (2) capable of opening and closing an open part of the mount surface (see Figures 1 and 2). The erecting operation part of the rod member has a rolling surface (i.e. bottom part of 4) that is rollable on the erecting action surface in an erecting direction of the rod member (see Figures 5 and 6). An erecting support surface (i.e. end of 5) is formed adjacent to and forward of the rolling surface at one end of the rod member and a ferromagnetic material (4) is provided in a vicinity of the erection support surface the first magnet has a first magnetic pole facing toward the one end of the rod member so that the magnetic force from the first magnetic pole acts on the erection support surface (see Figures 1-3, abstract). The container (1) has a second magnet (3) provided in a vicinity of the erecting action surface so that magnetic force from the second magnet acts on the erecting action surface (see Figure 1). The rod member is constantly urged to pivot in the erection direction by magnetic attraction force between the ferromagnetic material and the second magnet so that the rod member is automatically shifable from the laying position to an erect position by rolling of the rolling surface second erection action surface (see Figures 1 and 3). The lid (2) of the container (1) has an erection

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restraining part (i.e. the position located next to mirror 7) capable of holding the rod member in the lying position on the mount surface against urging force acting on the rod member in the erecting direction when the lid is closed (see Figure 2).

Regarding claims 4 and 15, Reference '504 discloses the lid opening and closing by pivoting around a pivot shaft (1a) and the erecting action surface being positioned on the mount surface closer to the pivot shaft of the lid and a pivoting direction of the rod member when shifting from the erect position to the lying position is the same as a pivoting direction of the lid from an open position to the closed position (see Figures 1 and 2).

Regarding claims 10 and 14, Reference '504 discloses the lid opening and closing by pivoting around a pivot shaft (1a) and the erecting action surface of the rod member is flat wherein when the rod member is in the erect position with the erection support surface facing the erecting action surface the rod member stands at a tilt to the pivot shaft of the lid that the rod member is shiftable from the erect position to the lying position on the mount surface by pivoting down toward the pivot shaft in linkage with a closing motion of the lid (see Figures 1 and 2).

Regarding claims 13 and 17, Reference '504 discloses the container being a case body of a cosmetic compact case and the rod member being a makeup brush (see Figure 1).

Claim Rejections - 35 USC § 103

13. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

14. Claims 3, 5, 8, 16, and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Japanese reference 2-249504 in view of Tan (US 6,390,434).

Regarding claims 3 and 8, Reference '504 discloses the claimed invention except for the erecting operation part of the rod member is formed from a spherical or ellipsoidal magnet and the rolling surface is a curved surface around the magnetic pole points operating as the first magnetic pole.

Tan teaches a spherical magnet (12) with a curved rolling surface (see Figure 5; column 2, lines 45-50). It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the magnet of Reference '504 with a spherical magnet as taught by Tan in order to allow the rod member to move in any direction (i.e. left or right).

Regarding claims 5 and 16, Reference '504 discloses the claimed invention except for the erection operation part is provided at one end of a cap wherein the cap has an opening that fits to a shape of the one end of the rod.

Tan teaches erection operation part provided at one end with a cap (24) wherein the cap has an opening (see Figure 6; column 3, lines 30-35). It would have been obvious to one having ordinary skill in the art at the time the invention was made to

modify the magnet of Reference '504 with a cap provided at one end of the erection operation part as taught by Tan in order to protect the magnet to extend their life.

Regarding claim 18, Reference '504 discloses the container being a case body of a cosmetic compact case and the rod member being a makeup brush (see Figure 1).

15. Claims 6, 7, and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Japanese reference 2-249504 in view of Joulia (US 6,286,521).

Regarding claim 6, Reference '504 discloses the claimed invention except for a second rod-shaped member side-by-side with the first rod member wherein the second rod member is formed with a second erecting action surface and the rod members are spaced from each other to an extend that when erecting operation parts of the rod members are positioned on the first and second erecting action surface the magnet of the first rod member does not attract a magnet of the second rod member.

Joulia teaches a first (31) and second rod-shaped member (32) side-by-side wherein the rod members are spaced from each other (see Figure 1). It would have been obvious to one having ordinary skill in the art at the time the invention was made to have the device of Reference '504 be made with a second rod-shaped member located next to the first rod member and having a second erecting action surface and a second magnet, since Joulia teaches that having two applicator members located side-by-side are will known in the art to provide the user with two applicator members. Further it has been held that mere duplication of the essential working parts of a device involves only routine skill in the art. *St. Regis Paper Co. v. Bemis Co.*, 193 USPQ 8.

Regarding claim 7, the combination of Reference '507 and Joulia disclose the claimed invention except for the first rod member and the second rod member pivoting toward each other when shifting from an erect position to a lying position. It would have been obvious to one having ordinary skill in the art at the time the invention was made to arrange the first and second rod members wherein the first and second members pivot toward each other when shifting from an erect position to a lying position, since it has been held that rearranging parts of an invention involves only routine skill in the art. In re Japikse, 86 UPSQ 70.

Regarding claim 12, the combination of Reference '504 and Joulia disclose the lid (2) opening and closing about a pivot shaft (1a) and a pivoting guide surface (i.e. the lid part next to mirror (7)) is formed on an inner side of the lid whereby when the lid is closed the pivoting guide surface abuts on distal ends of the rod members and guides the rod members so that the rod members pivot toward each other.

16. Claims 11 and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Japanese reference 2-249504 in view of Kunik et al. (US 3,982,631).

Regarding claims 11 and 19, Reference '504 discloses the claimed invention except for the erecting action surface is linearly slanted so that when the rod member is in the erect position with the erection support surface facing the erection action surface the rod member stands at a tilt.

Kunik et al. teaches the erecting action surface (41) being linearly slanted so that when the rod member is in the erect position with the erection support surface facing

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the erection action surface the rod member stands at a tilt (see Figures 2 and 8; column 3, lines 20-30). It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the erecting action surface of Reference '504 to be linearly slanted as taught by Kunik et al. in order to allow rod member to be provided at an angle.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to RACHEL A. RUNNING whose telephone number is (571)272-1917. The examiner can normally be reached on Monday-Friday 7:00 am - 4:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cris Rodriguez can be reached on (571) 272-4964. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Robyn Doan/
Primary Examiner, Art Unit 3732

/Rachel A. Running/
Examiner
Art Unit 3732

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